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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/800,096	03/12/2004	Richard M. Hogan	4022-000014	8094
27572	7590	07/14/2008		
HARNESS, DICKEY & PIERCE, P.L.C. P.O. BOX 828 BLOOMFIELD HILLS, MI 48303				
EXAMINER				
DESAL, ANISH P				
ART UNIT		PAPER NUMBER		
1794				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/800,096

**Applicant(s)**

HOGAN ET AL.

**Examiner**

ANISH DESAI

**Art Unit**

1794

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 May 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 22-30 and 47-54 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 22-30 and 47-54 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed on 05/15/08. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 05/15/08 has been entered.
2. Claims 1-21 and 31-46 are cancelled. Claims 22-30 and 47-54 are pending. Claims 47-54 are new claims.
3. The art rejections based on Katsuki et al. (US 4,427,743) are withdrawn in view of the present amendment and response. Katsuki does not teach or suggest "wherein the expendable polymeric layer is capable of being readily separated from the adhesive layer" as presently claimed. However, upon further consideration a new 35 USC Section 103(a) rejection based on Takahira et al. (US 6,395,360B1) in view of Gerard et al. (US 5,929,167) is made.
4. A new objection to the specification is made.
5. A new 35 USC Section 112-first paragraph rejection to claim 52 is made.

### ***Specification***

6. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: Claim 29 requires thickness of the thermoplastic polyurethane layer to be 0.005 to 0.1 inches. The specification fails to provide

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antecedent basis for the limitation of "0.1 inches". As disclosed in paragraph 0035 of US Patent Application Publication 2005/0202198A1, the specification recites "In a preferred embodiment...it is convenient to choose the thermoplastic polyurethane adhesive layer with a thickness of from about 0.005"-0.09"...2.3 mm)". Since, the claim limitation of 0.1 in is presented in the original claims; the specification can be amended to overcome the aforementioned objection.

### ***Double Patenting***

7. Applicant is advised that should claim 49 be found allowable, claim 54 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k). Claims 49 and 54 depend from the independent claim 47 and both require that the layer A be a polypropylene.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claim 52 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one

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skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

9. Claim 52 requires the thickness of the adhesive layer to be "0.005-0.01 inches".

The specification does not support this; the specification recites the thickness of the adhesive layer to be 0.005 to 0.09 inches (see paragraph 0035 of US Patent Application Publication 2005/0202198A1 of this application). Accordingly, specification fails to explicitly provide support for "0.01 inches".

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 22-26, 28-30, and 47-54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takahira et al. (US 6,395,360B1) in view of Gerard et al. (US 5,929,167).

11. It is noted that Applicant has recited transitional phrase of "wherein", the transitional phrase of "wherein" may raise an issue of claim scope (see MPEP 211.04), therefore it may be helpful to replace the transitional phrase of "wherein" with the transitional phrases such as "comprising", "consisting essentially of", "consisting" etc. Such transitional phrases may be better in characterizing Applicant's invention.

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12. With respect to claims 22, 26, and 47, Takahira discloses a pressure-sensitive adhesive sheet having release liner (4, 4) applied on both sides of a layer of pressure sensitive adhesive 5 (see abstract, Figure 2, and column 6 lines 26-45). The release liner (4, 4) of Takahira is formed of polymeric material (column 3 lines 50-65 and column 4 lines 10-22) and it exhibits good release function (abstract). The release liner (4, 4) of Takahira is thus equated to expendable polymeric layer A that is capable of being readily separated from the adhesive layer B. Additionally, the adhesive sheet as shown in Figure 2 of Takahira is equated to A-B-A composite sheet, wherein the layer A being the release liner 4 and the layer B being the PSA layer 5.

13. With regards to the claim limitation of "co-extruded A-B-A composite sheet", the phrase "co-extruded" is interpreted to be a product-by-process limitation. The product by process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps. "Even though product by process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product by process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985).

14. Once the Examiner provides a rationale tending to show that the claimed product appears to be the same or similar to that of the prior art, although produced by a different process, the burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art

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product. *In re Marosi*, 218 USPQ 289, 292 (Fed. Cir.1983). In the instantly claimed subject matter, a three-layer A-B-A composite sheet of Applicant comprise expandable polymeric layer A and a thermoplastic adhesive layer B. Further, the claim language does not explicitly exclude other layers from being present in the three-layer A-B-A composite sheet. Moreover, the presently claimed invention requires that layer A be capable of being readily separated from the adhesive layer. The adhesive sheet (composite sheet) of Takahira is previously disclosed and it includes an adhesive layer 5 (layer B) that is covered on both sides with a release liner (4, 4) (layer A) (Figure 2). Further, the release liner (4, 4) of the adhesive sheet of Takahira is functionally capable of being readily separated from the adhesive layer (abstract). Therefore, the Examiner sees no unobvious difference between the claimed composite sheet and that of Takahira.

15. Regarding claims 22, 26, and 47, the difference between the claimed invention and the prior art of Takahira is that Takahira is silent as to teaching a thermoplastic adhesive layer and the adhesive layer comprising a thermoplastic polyurethane. However, Gerard discloses a pressure sensitive adhesive composition and articles containing the pressure sensitive adhesive composition; wherein the PSA composition of Gerard comprises thermoplastic polyurethane (abstract). According to Gerard, the PSA based on thermoplastic polyurethane has a better tack and cohesion properties and exhibits enhanced stability (column 1 lines 34-45). It is noted that the primary reference of Takahira discloses that no particular limitation is imposed on the pressure sensitive adhesive (column 5 lines 13-17). Therefore, it would have been obvious to

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one having ordinary skill in the art at the time the invention was made to use the PSA composition comprising thermoplastic polyurethane as taught by Gerard in the invention of Takahira, motivated by the desire to use an adhesive that has a better tack, cohesion properties, and enhanced stability.

16. With respect to claims 23-25, 48, 49, and 54, it is noted that the release liners (layer A) of Takahira comprise polyethylene (column 3 lines 30-35) and polypropylene (column 4 lines 15-17).

17. Regarding claims 28, 29, 50-52, Takahira discloses "Total thickness of the release liner can be selected as needed within an extent not damaging the strength, handling properties or the like, but generally it is about 20 [0.00078 in] to 200  $\mu\text{m}$  [0.0078 in using 1  $\mu\text{m}$  = 0.000039 in]." (column 4 lines 35-40). Moreover, the thickness of the adhesive layer of Takahira is generally from 1 to 200  $\mu\text{m}$  (column 6 lines 5-8), which converts to 0.000039 in to 0.00787 in respectively.

18. With respect to claim 53, as stated previously the release liner of Takahira comprises polypropylene (column 4 lines 15-17).

19. With regards to limitation of claim 30, it is reasonable to presume that this imitation is present in the invention of Takahira as modified by Gerard. The support for said presumption is based on the fact that the three layer A-B-A composite sheets of Applicant and that of Takahira as modified by Gerard include expendable polymeric layer A and a thermoplastic adhesive layer B. Further, the expendable polymeric layers A of Applicant and that of Takahira as modified by Gerard are capable of being readily separated from the adhesive layer. Therefore, the aforementioned claim limitation



would be present in the invention of Takahira as modified by Gerard. The burden is shifted to Applicant to prove it otherwise (see *In re Fitzgerald*, 205 USPQ 594).

20. Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Takahira et al. (US 6,395,360B1) in view of Gerard et al. (US 5,929,167) as applied to claim 22 above, and further in view of Schacht et al. (US 5,096,777).

21. Takahira is silent as to teaching the adhesive layer comprises a plurality of individual adhesive sheets. However, Schacht discloses a double-sided adhesive tape without a backing (see title). The disclosure of Schacht beginning at column 2 lines 19 to column 2 lines 45 is interpreted as Schacht disclose plurality of individual adhesive sheets that are covered on both sides with a release paper. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use plurality of individual adhesive sheets, motivated by the desire to enhance the strength of the adhesive tape.

### ***Conclusion***

22. Any inquiry concerning this communication or earlier communications from the examiner should be directed to ANISH DESAI whose telephone number is (571)272-6467. The examiner can normally be reached on Monday-Friday, 8:00AM-4:30PM.

23. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney can be reached on 571-272-1284. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

24. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for

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published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/A. D./

Examiner, Art Unit 1794

/Hai Vo/

Primary Examiner, Art Unit 1794